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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS D. DOERR and KEVIN STEHLIN

Appeal 2009-015111
Application 09/888,532
Technology Center 3600

Before MURRIEL E. CRAWFORD, ANTON W. FETTING and JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

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STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-21. We have jurisdiction under 35 U.S.C. § 6(b). (2002)

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Appellants claim a system and method for capturing detailed diagnosis treatment information in a manner that minimizes disruption to the physician's workflow. (Specification: [0008]).

Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A patient-side decision support system comprising:
 - a hand-held terminal usable during an examination and providing a display and user input device;
 - a terminal server communicating with the hand-held terminal and holding medical information related to medical diagnoses as linked to a set of diagnosis codes, the terminal server further executing a stored program to:
 - (a) accept from the user input device of the hand-held terminal, input designating a methodology producing a subset of the diagnoses codes;

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(b) present on the display of the hand-held terminal a navigation menu a representation of the subset of the diagnosis codes generated using the selected methodology;

(c) accept from the user input device of the hand-held terminal a selection of a particular diagnosis codes from the subset; and

whereby a comprehensive set of diagnosis codes can be present to the physician on a hand-held device at the time and location of patient examination.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

The Examiner rejected claims 1, 7, 10-12, 15, and 17-21 under 35 U.S.C. §102(b) as being anticipated by Evans (US 5,924,074, issued Jul. 13, 1999).

The Examiner rejected claims 2-6 and 8-9 under 35 U.S.C. §103(a) as being unpatentable over Evans in view of Abbo (US 2003/0195774 A1, publ. Oct. 16, 2003).

The Examiner rejected claim 16 under 35 U.S.C. §103(a) as being unpatentable over Evans in view of Abbo and in further view of Rappaport (US 2002/0007285 A1, publ. Jan. 17, 2002).

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The Examiner rejected claims 13 and 14 under 35 U.S.C. §103(a) as being unpatentable over Evans in view of Abbo and in further view of Mayaud (US 5,845,255, issued Dec. 1, 1998).

ISSUE

The anticipation issue turns on whether Evans discloses designating a methodology producing a subset of the diagnoses codes when the physician selects a given body system which in turn generates the diagnosis codes.

The issue of obviousness turns, inter alia, on whether a person with ordinary skill in the art would understand that a physician includes specialists, such as a dermatologist, who is part of a predetermined set of physicians who deal with skin related issues.

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. We adopt the Examiner's findings as our own as set forth in the Answer on pages 5-14, and further make the following additional findings.
2. Appellants' Specification does not specifically define the term "methodology," nor does it utilize the term contrary to its customary meaning.
3. The ordinary and customary definition of the term "methodology" as defined by Merriam Webster's Dictionary is: "a particular procedure or a set of procedures." Merriam Webster's Dictionary,

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<http://www.merriam-webster.com/dictionary/methodology> (last visited Dec. 8, 2011).

4. Evans discloses:

[T]o enter a diagnosis, a physician clicks on the scroll down button **331** adjacent to the system box **332** to produce a list of body systems. The physician selects the appropriate system and the diagnosis module **300** enters the selected system in the system box **332** and provides a list having specific diagnosis codes for the selected body system in the diagnosis box **334**.

(Col. 11, ll. 40-46).

ANALYSIS

We affirm the rejections of claims 1-21 under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a).

The 35 U.S.C. § 102 (b) Rejection

The nub of Appellants' argument against the anticipation of independent claim 1 by Evans is as follows:

Evans only allows a physician to receive a subset of diagnoses codes based on a single methodology: body part selection. Hence, Evans cannot be said to teach or suggest designating a methodology for selecting a subset of diagnoses codes because it would clearly be unnecessary to select a methodology when only one methodology is possible.

(Appeal Br. 4).

We disagree with Appellants.

We find that the Appellants' Specification does not specifically define the term *methodology*, nor does it utilize the term contrary to its customary meaning. (FF 2). The ordinary and customary definition of the term "*methodology*" as defined by Merriam Webster's Dictionary is "a particular procedure or a set of procedures." (FF 3). We therefore construe a methodology to include a single procedure. This interpretation is consistent with claim 1 which only requires that a user designate a methodology.

We thus find that Evans discloses the claim requirement of *designating a methodology producing a subset of the diagnoses codes* because when the physician selects a given body system, he/she so designates the body system as a methodology by using it, which in turn generates the diagnosis codes. (FF 4).

Appellants also argue that "... the inputting of a methodology is not the mere selection of a body part, as taught by Evans, but the selection of a specific method from a plurality of methods by which the physician would like the diagnostic codes to be limited to a particular subset." (Appeal Br. 6).

We are not persuaded by Appellants' argument. The arguments "fail from the outset because . . . they are not based on limitations appearing in the claims . . .," (*In re Self*, 671 F.2d 1344, 1348 (CCPA 1982)) and are not commensurate with the broader scope of claim 1 which merely recites a methodology and not a "selection of a specific method from a plurality of methods" as argued by Appellants. (Appeal Br. 6).

35 U.S.C. § 103(a) Rejections

Concerning claims 2-4, we find no error with the Examiner's finding that the disclosure in Abbo of a "physician's office" at ¶[0058] would also be understood by a person with ordinary skill in the art to include a specializing physician, such as a dermatologist, who is part of a predetermined set of physicians, which predetermination is set by an expertise exclusively related to skin issues. (Answer 18-19).

We also find no error in the Examiner's finding that a person with ordinary skill in the art would infer that Abbo's list of common diagnoses would also provide the most frequently used diagnoses and hence corresponding codes for the user physician's office because, for example, a dermatologist would use codes frequently related to skin issues rather than to gastrointestinal tract issues. *See KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). (In making the obviousness determination one "can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.")

Concerning claim 5, we again find no error in the Examiner's finding that Abbo's disclosure of a physician selecting a diagnosis from a patient's previous diagnoses meets the claim requirement of *providing most recent diagnosis codes for the patient*. We are not persuaded by Appellants' argument that "Abbo teaches that prior diagnoses, at best, are limited to 'major diagnoses' and not to the 'most recent'" (Appeal Br. 9) because Abbo at ¶[0057] uses "e.g." when discussing major diagnoses which is an abbreviation used to expand by example, and not constrict to a given

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definition as Appellants propose.

We are further not persuaded by Appellants' argument as to claims 13 and 14 that "there is no teaching or suggestion within the art of record and the Examiner has not provided evidence that one of ordinary skill in the art would otherwise be inclined to combine an electronic medical practice/records management with an electronic prescription management system." (Appeal Br. 10) This is because to the extent Appellants seek an explicit suggestion or motivation in the references themselves, this is no longer the law in view of the Supreme Court's recent holding in *KSR* at 418-419. Since the Examiner has provided some articulated reasoning with some rational underpinning for why a person with ordinary skill in the art would modify Evans to be personalized "to the prescribing patterns of experienced professionals" (Answer 13), Appellants' argument is not persuasive as to error in the rejection.

CONCLUSIONS OF LAW

We conclude the Examiner did not err in rejecting claims 1, 7, 10-12, 15, and 17-21 under 35 U.S.C. §102(b) as being anticipated by Evans; claims 2-6 and 8-9 under 35 U.S.C. §103(a) as being unpatentable over Evans in view of Abbo; claim 16 under 35 U.S.C. §103(a) as being unpatentable over Evans in view of Abbo and in further view of Rappaport; and claims 13 and 14 under 35 U.S.C. §103(a) as being unpatentable over Evans in view of Abbo and in further view of Mayaud.

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DECISION

The decision of the Examiner to reject claims 1-21 is

AFFIRMED

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